

Applicants respectfully traverse this objection and assert that the amendment to page 3 of the specification does not introduce any new matter. However, in the interest of advancing the prosecution of this application, the paragraph objected to by the Patent Office has been deleted as not being required. Accordingly, withdrawal of this objection is warranted.

Referring to the claims, claims 3-8 and 11-17 are pending in the subject application. The Patent Office indicates that all of these claims are allowable in view of the prior art. (Action, page 4).

However, the Patent Office rejects claims 3-8 and 11-17 under the first paragraph of 35 U.S.C. § 112, alleging lack of written description and lack of enablement. In particular, the Patent Office alleges that the “specification does not disclose whether the alloy is noted in weight or atomic percent.” (Action, page 3). The Patent Office also alleges that the “proper notation of the percentages, whether atomic or weight, of the alloy is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.” (Action, page 3). The Patent Office further alleges that the terms “by weight percent” added to the claims constitute new matter. Applicants respectfully traverse these rejections.

The Patent Office has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in Applicants’ disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (C.C.P.A. 1976). In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000).

Applicants respectfully assert that, at the time the subject application was filed, one of ordinary skill in the art would have known that the composition of the alloys used in Applicants’ inventive conductive strip were described in terms of percentage-by-weight. For example, Table 1 at page 3 of Applicants’ specification sets forth the compositions of alloys A-G and uses the terms “%” and “Remainder,” which are commonly employed in the

metallurgical arts to recite compositions of alloys on a percentage-by-weight basis. Similarly, the particular alloys set forth in column 1, Table 2 at page 4 of Applicants' specification employ notation (e.g. a number following an element) commonly used in the metallurgical arts to express an alloy in weight percent.

Moreover, in Applicants' response of July 12, 2000, Applicants submitted Exhibits 1 and 2, which both concern copper alloys and are taken from learned treatises on the subject of metallurgy. The Patent Office's attention is respectfully directed to the previously provided exhibits. Exhibits 1 and 2 describe the composition of copper alloys in terms of the percentage of the constituent metals, without any express reference to the basis - weight or molar - on which such percentages are calculated. Applicants respectfully submit that one skilled in the metallurgical arts would recognize that the percentages recited in these Exhibits, and in the subject application, are on a weight basis because it is customary in the metallurgical arts to express compositions of alloys on a percentage-by-weight basis by referring to "percentages" or "%."

As further evidence of the custom in the metallurgical arts of reciting compositions of alloys as percentages without stating expressly that percentages are percentages-by-weight, Applicants respectfully direct the Patent Office's attention to Exhibit 3 of Applicants' July 12, 2000 response. This Exhibit, U.S. Patent 4,179,313, describes the composition of an aluminum alloy, without expressly reciting that the percentages are percentages-by-weight.

Applicants respectfully submit that, at the time the subject application was filed, the artisan skilled in the metallurgical arts would have recognized that the composition of copper alloys recited in Applicants' specification was described as percentage-by-weight and, therefore, such artisan also would have been aware that Applicants were in possession of the claimed invention.

At pages 4-5 of the outstanding March 13, 2001 Office Action, with respect to maintaining the § 112 rejections, the Patent Office asserts that "[i]t has been established that compositions directed to alloys used in electrical applications are not solely reported in weight percent and are reported using both notations." Apparently, reference is being made

to patents cited by the Patent Office at page 6 of the prior Office Action. Applicants respectfully submit that it matters not that alloy compositions may be reported using both notations. Rather, it is Applicants' position that, in the absence of an express indication that a percentage is on either a "weight" or "atomic" basis, one skilled in the art would understand a notation of % as describing percentage-by-weight, as in the subject application.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the Patent Office's rejection for lack of adequate written description. Similarly, for at least these reasons, the Patent Office rejections for lack of enablement and support also should be reconsidered and withdrawn.

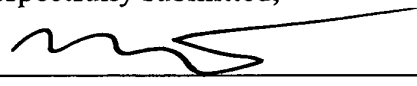
Additionally, in accordance with 37 C.F.R. § 1.121, attached hereto is a marked-up version of the changes made by the present Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

The Patent Office is authorized to charge any required fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

For the preceding reasons, it is respectfully submitted that the application is in condition for immediate allowance. A Notice of Allowance is therefore respectfully requested.

Dated: October 24, 2002

Respectfully submitted,



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Version with Markings to Show Changes Made

In the Specification:

On page 3, line 16, delete the paragraph: “Table 1, as well as the remainder of the specification, specifies the composition of the material by percentage weight.”